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### REMARKS

Claims 15-18, 20 and 22-40 are pending in the present application. In the Non-Final Office Action mailed April 5, 2007, claims 22-24 have been allowed, and claims 15-18, 20 and 25-40 stand rejected. Claims 15, 25-31, 33, 35, 36 and 39 have been amended in this response. Reconsideration of the present application as amended and in view of the remarks that follow is respectfully requested.

Claim 39 has been amended to depend from claim 38 rather than claim 37.

Claims 15, 35 and 36 were objected to for lacking antecedent basis for certain features as identified in the Office Action. Claims 15, 35 and 36 have been amended above to address the objections. Withdrawal of the objections to claims 15, 35 and 36 is respectfully requested.

Claim 25-30 were rejected under 35 USC §112, second paragraph for depending from cancelled claim 19. Claims 25-30 have been amended to depend from allowed claim 22. Withdrawal of the rejection of claims 25-30 is respectfully requested.

Claims 15-17, 20, 31-33, 35, 38 and 40 stand rejected under 35 USC §102(b) as being anticipated by EP 0646366 to Steffee. It is well established that "an invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The claims must not be treated as "mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 1459, 221 USPQ 481, 486 (Fed. Cir. 1984). As a result, a reference that coincidentally lists features of a claim without describing the claimed arrangement, relationship, and organization of such features cannot anticipate.

Claim 15 has been amended to clarify the relationship between the distal head and the cutting portion. Specifically, amended claim 15 now recites "...the cutting portion being positioned distal to the first non-cutting portion ... a second non-cutting portion fixed to said cutting portion, said second non-cutting portion defining a distal head extending distally from said cutting portion..." in combination with the other elements and features in claim 15. Support

for the amendments to claim 15 may be found, for example, in Figures 2, 4 and 5 and page 10, lines 22-24 of the specification.

With respect to Steffee, the Office Action asserts that the first non-cutting portion is the small diameter portion 110, the cutting portion is spinal implant 10, and the second non-cutting portion is extension 136. As shown in Figures 9-12 of Steffee, when extensions 136 are engaged to spinal implant 10, spinal implant 10 is positioned distal to small diameter portion 110, but extension 136 extends from the proximal end of the implant and along a portion of the length of spinal implant 10 so that it does not extend distally from spinal implant 10. Therefore, claim 15 distinguishes Steffee and withdrawal of the rejection of claim 15 is respectfully requested.

Claims 16-17 and 20 depend from claim 15 and distinguish Steffee at least for the reasons claim 15 does. Withdrawal of the rejection of these claims is also respectfully requested.

Claim 31 has been amended to clarify the relationship between the distal head and the cutting portion. Specifically, amended claim 31 now recites, in combination with the other elements and features of claim 31, "...a shaft defining a longitudinal axis and having a first end connected to a handle and an opposite, second end; a first non-cutting portion positioned about the shaft between the handle and the second end; a cutting portion extending from the second end of the shaft and including a first pair of generally parallel faces and a second pair of faces configured to cut the first and second endplates; a second non-cutting portion adjacent to said cutting portion, said second non-cutting portion defining a distal head that is located on the longitudinal axis...." Support for the amendment may be found, for example, in Figures 2, 4 and 5 and page 10, lines 22-24 and page 11, lines 1-16 of the specification.


With respect to Steffee, the Office Action asserts that the shaft is shaft 118, the first non-cutting portion is the small diameter portion 110, the cutting portion is spinal implant 10, and the second non-cutting portion is extension 136. As shown in Figures 9-12 of Steffee, when spinal implant 10 is engaged to instrument 80, extension 136 extends from the proximal end of spinal implant 10 and along a side of spinal implant 10 in offset relation to the longitudinal axis of shaft 118. Extension 136 is not located on the longitudinal axis of shaft 118. Therefore, claim 31 distinguishes Steffee and withdrawal of the rejection of claim 31 is respectfully requested.

Claims 32, 33, 35, 38 and 40 depend from claim 31 and distinguish Steffee at least for the reasons claim 31 does. Claim 33 has been amended to clarify the relationship between the heights of the first and second non-cutting portions and the cutting portion. Support for the amendment may be found, for example, in Figures 4 and 5 and in the specification at page 10, lines 6-12, 26-29 and page 12, lines 13-21. Withdrawal of the rejection of these claims is respectfully requested.

Dependent claims 18, 34, 37 and 39 stand rejected under 35 USC §103(a) as being unpatentable over Steffee in view of U.S. Patent No. 5,425,772 to Brantigan. Dependent claim 36 stands rejected under 35 USC §103(a) as being unpatentable over Steffee in view of U.S. Patent No. 5,609,636 to Kohrs et al. These claims depend directly or indirectly from claims allowable for at least the reasons provided above. Accordingly, withdrawal of the rejections of these claims is respectfully requested.

In view of the foregoing remarks, it is respectfully submitted that the Applicant's application is in condition for allowance with pending claims 15-18, 20, and 22-40. Reconsideration of the subject application is respectfully requested. Timely action towards a Notice of Allowability is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the subject application.

Respectfully submitted,

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Response to Non-Final Office Action  
Application Serial No. 10/825,767  
Page 10 of 10